

### **REMARKS**

Claims 1-4, 7-13, 19, 20, and 22-25 are pending in the present application. Claims 23-25 are new. Claims 1 and 7 have been amended. Claims 1, 7, and 19 are independent claims. The Examiner is respectfully requested to reconsider the rejections in view of the above amendments and the following remarks.

#### ***Allowable Subject Matter***

It is gratefully acknowledged that the Examiner considers the subject matter of claim 7 as being allowable if rewritten in independent form. Although not conceding the appropriateness of the Examiner's rejections, claim 7 has been rewritten in independent form (with an additional amendment for clarity). As such, claim 7 is now in condition for allowance.

#### ***Rejection Under 35 U.S.C. § 103***

Claims 1-4, 8-13, 19, 20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sprenger et al., "H-BLOB: A Hierarchical Visual Clustering Method Using Implicit Surfaces," IEEE, October 2000 (hereafter "Sprenger"). This rejection is respectfully traversed.

#### **Sprenger Fails to Teach/Suggest Every Claimed Feature**

Initially, Applicant respectfully points out that in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In this rejection, the Examiner states the following:

"...Sprenger also teaches an application of the clustering process []for document retrieval visualization and thus, if a user were to edit a location of a document (object) and re-run the cluster visualization, the object could then be automatically moved from one affinity region to another based on the editing of the object (document) by the user. Examiner takes

official notice that it is well known in the art for users to edit documents”  
(Office Action at paragraph bridging pages 3–4).

Accordingly, it is clear that the Examiner’s rejection hinges on the proposition that the claimed “design elements” read on the text documents in Sprenger’s disclosed Document Retrieval Visualization (section 4.3). However, independent claims 1 and 19 clearly recite that the design elements are “entities of a process or system being designed by a user,” which do not read on the Sprenger’s documents. Accordingly, Sprenger fails to teach or suggest the claimed design objects.

#### **Proposed Modification Renders Sprenger Unsatisfactory for Intended Purpose**

In page 3 of the Office Action, the Examiner admits that Sprenger fails to teach or suggest “automatically moving the shapes of design elements sharing a particular one of the characteristics into an affinity region for the particular characteristic, such that the moved shapes are located in proximity to each other on the visual design surface.” However, to remedy this deficiency, the Examiner proposes modifying Sprenger to allow the user to edit a document and then re-run the cluster visualization, thereby causing the document to be automatically moved to a cluster.

To provide a rationale for this proposed modification, the Examiner makes the following statement:

“It would have been obvious to allow user to edit documents (objects) into the system of Sprenger because providing the functionality of correcting or modifying data for the user to enhance overall accuracy of the visual presentation can be realized” (Office Action at page 4, 1<sup>st</sup> paragraph).

Here, the Examiner appears to be asserting that it would have been obvious to modify Sprenger to allow a user to edit the document in order to move the document into a desired cluster. In other words, the Examiner wants to change the end result of Sprenger’s invention from that of clustering the objects to help a user visualize the data contained therein to that of

modifying the data content to help the user achieve a desired clustering of objects. Accordingly, the Examiner wants to modify the intended purpose of Sprenger's invention.

In response, Applicant respectfully refers the Examiner to MPEP § 2143.01.V, which states:

“If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).”

Since the Examiner's proposed modification would change the intended purpose of Sprenger's invention, thus rendering it unsatisfactory for its intended purpose, Applicant respectfully submits that the Examiner's proposed modification is improper under § 103.

#### **Other Deficiencies in Rationale to Modify**

Furthermore, the Examiner's rationale for modifying Sprenger employs circular logic. In essence, the Examiner asserts it would be obvious to allow a user to change the data within the documents in order to achieve a certain clustering, which would then be used to help visualize the data within those documents. Applicant submits that such logic would not provide a proper rationale for modifying Sprenger.

In addition, the Examiner relies on the “distance between their centroids” for the characteristics associated with Sprenger's objects (documents) (see Office Action at page 3, lines 7-9). While the Examiner asserts that it would have been obvious for a user to edit Sprenger's document to change this characteristic in order to “enhance overall accuracy,” the Examiner has not offered any explanation as to what type of edits would be required to enhance the overall accuracy of the distances between centroids. For this additional reason, Applicant submits that the Examiner's proposed modification of Sprenger is improper.

### **Independent Claims 1 and 19 are Allowable**

At least for the reasons set forth above, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to independent claims 1 and 19.

### **Amendment to Claim 1 further Distinguishes over Sprenger**

While Applicant believes that claim 1 is allowable at least for the reasons set forth above, Applicant has amended claim 1 in an effort to expedite prosecution by further distinguishing the claimed invention over Sprenger. Specifically, claim 1 has been amended to recite, “wherein the determination of the characteristic associated with each design element is independent of the determination of the characteristics associated with the other design elements.”

Conversely, Sprenger’s clusters are based on the proximity of the objects in the coordinate space. Thus, Sprenger uses relative characteristics between objects to determine whether they are to be clustered together. In fact, Sprenger expressly states that “[t]he system is based on quantifying the *similarity of related objects*” (Section 1, 7<sup>th</sup> paragraph). Therefore, Sprenger fails to teach or suggest that the characteristic causing a design element to be associated with an affinity region is determined independent of the determined characteristics of other design elements, as claimed. Thus, the aforementioned amendment provides yet another reason why claim 1 is allowable over Sprenger.

### **Examiner Requested to Withdraw Rejection**

In view of the foregoing, Applicants submit that independent claims 1 and 19 are in condition for allowance. Accordingly, claims 2-4, 8-13, 20, and 22 are allowable at least by virtue of their dependency on claims 1 and 19. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

*Conclusion*

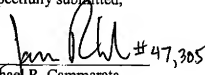
In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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